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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,786	01/05/2001	Joseph L. Hellerstein	YOR920000318US1	5258

7590 05/13/2004  
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EXAMINER
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NGUYEN BA, HOANG VU A

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/755,786

Applicant(s)

HELLERSTEIN ET AL.

Examiner

Hoang-Vu A Nguyen-Ba

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to amendment filed March 15, 2004.
2. Claims 1-22 remain pending.

### *Response to Argument*

3. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 6-7 and 15-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Per claims 6-7 and 15-16, the limitations *the step of also permitting manual control over the installation of the software package on the target machine* and *wherein the manual control over the installation of the software package in a target machine is effectuated by setting a flag* do not appear to be supported in the specification. The two locations in the specification where manual operation is mentioned is: 1) page 1, last paragraph (i.e., "Existing approaches for "push-based" software distribution usually require the manual selection of potential distribution targets"); and 2) page 14, Step 701 (i.e., "The arrival

of the package can be indicated manually by an administrator or..."). Manual control over the installation and the manual control setting by a flag are not specifically described at these identified locations of the specification. Furthermore, this feature is admitted by applicants to be prior art when applicants describe the commonly known technique of push-based software distribution.

6. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Per claims 1 and 21, the limitations:

a. *preparing a base software package for each of the one or more regions based on at least one of: (i) policy data indicating which of the one or more regions are candidates for receiving the software package, (ii) dependency information indicating requisites for a service provided by the software package, and (iii) configuration information for each of the candidate regions; and*

b. *customizing the base software package received at each of the candidate regions based on at least one of: (i) regional distribution policies, (ii) dependency information specific to one or more roles performed by the target machines in that region, and (iii) individual target machine configuration information*

are unclear because of the use of the **at least one of** : (i), (ii), (iii). Since it is unclear whether the step of preparing a base software package is based on just one, or two, or all three of the sub-limitations (i), (ii), (iii);

- a. the step of preparing is interpreted to be based on (iii), i.e., *configuration information for each of the candidate regions*; and
- b. the step of customizing is interpreted to be based on (iii), i.e., *individual target machine configuration information* for art rejection purposes.

### *Claim Rejections – 35 U.S.C. § 102*

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4, 8-9, 10-13, 17-18, 21 and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Applicant's Admitted Prior Art (AAPA).

The AAPA discloses at least:

*preparing a base software package for each of the one or more regions based on configuration information for each of the candidate region* (see at least Figure 1, step 1 and related discussion in the specification);

*distributing the base software package to each of the candidate regions of the distributed network* (see at least Figure 1, step 5 and related discussion in the specification);

*customizing the base software package received at each of the candidate regions based on individual target machine configuration information* (see at least Figure 1, step 6 and related discussion in the specification); and

*distributing the software package customized in each of the candidate regions to at least one of the target machines in the candidate regions of the distributed network (see at least Figure 1, step 6 and related discussion in the specification).*

### **Claims 2 and 11**

Since the Office's interpretation of claim 1 does not give weight to the limitation (ii) because of how the claim is being written (see section 8 above), the art rejection of features of claims 2 and similar claim 11 is not considered.

However, it is noted that although AAPA does not specifically disclose *wherein the dependency information indicating requisites for a service provided by the software package comprises at least one of a pre-requisite, an ex-requisite and a co-requisite associated with installation of the software package on a target machine*, these features are deemed to be inherent in AAPA as shown in Figure 1, steps 1, 2, 3 and item 16, and related discussion in the specification.

### **Claims 3 and 12**

Since the Office's interpretation of claim 1 does not give weight to the limitation (ii) because of how the claim is being written (see section 8 above), the art rejection of features of claims 3 and similar claim 12 is not considered.

Furthermore, assuming *arguendo*, that these features are being given weight, it is noted that although AAPA does not specifically disclose *wherein the dependency information indicating requisites for a service provided by the software package is represented in the form of a multi-level tree*, this feature is deemed to be inherent in AAPA as shown in Figure 1, steps 1, 2, 3 and item 16, and related discussion in the specification.

### Claims 4 and 13

Since the Office's interpretation of claim 1 does not give weight to the limitation (ii) because of how the claim is being written (see section 8 above), the art rejection of features of claims 4 and similar claim 13 is not considered. Furthermore, assuming *arguendo*, that these features are being given weight, it is noted that although AAPA does not specifically disclose *wherein one or more of leaves of the tree represent one or more software components*, this feature is deemed to be inherent in AAPA as shown in Figure 1, steps 1, 2, 3 and item 16 and related discussion in the specification.

### Claims 8 and 17

AAPA further discloses *the step of maintaining a policy repository indicating steps needed to construct distributable component packages for different regions and different end user environments* (see at least Figure 1, step 3 and item 16; and related discussion in the specification).

### Claims 9 and 18

AAPA further discloses *wherein the individual target machine configuration information used to customize the base software package received at a candidate region is one of stored prior to use and determined at the time of use* (see at least Figure 1, step 2 and related discussion in the specification).

### Claim Rejections – 35 USC § 103

11. The following is a quotation of the 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter

sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA as applied to the base claims, in view of U.S. Patent No. 6,484,247 to Gendron et al. ("Gendron").

### **Claims 5 and 14**

AAPA does not specifically disclose *wherein the one or more roles performed by the target machines in a region comprise a client role, a server role and a standalone role*. However, Gendron discloses a network that can contain any combination of client and server systems and the nodes inside this network can be standalone systems (5:59 – 6:8) for the purpose of improving the installation of software installation in a network system. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine this feature with AAPA for the purpose set forth above.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Antony Nguyen-Ba, whose telephone number is (703) 305-0103. The examiner can normally be reached on Tuesday - Friday from 6:15 – 3:45 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam, can be reached at (703) 305-4552.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Central Fax Number

(703) 872-9306

*Anthony Nguyen-Ba*

**ANTONY NGUYEN-BA  
PRIMARY EXAMINER**

Art Unit 2122

May 11, 2004